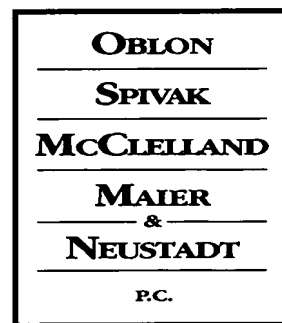




2141
IFW

Docket No.: 275756US6

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 09/853,325

Applicants: Naoya SUZUKI

RCE Filed: July 19, 2005

For: MAIL-ARRIVAL NOTIFICATION SYSTEM, MAIL-
ARRIVAL MONITORING APPARATUS, MAIL
SERVER APPARATUS MOBILE
COMMUNICATION TERMINAL, INFORMATION
PROCESSING APPARATUS, MAIL ACQUISITION
INSTRUCTING METHOD, MAIL ACQUIRING
METHOD, AND PROGRAM STORING METHOD

Group Art Unit: 2141

Examiner: Le Hien Luu

SIR:

Attached hereto for filing are the following papers:

REQUEST TO WITHDRAWAL HOLDING OF ABANDONMENT

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Bradley D. Lytle

Registration No. 40,073

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)



DOCKET NO: 275756US6

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
NAOYA SUZUKI : EXAMINER: LE HIEN LUU
SERIAL NO: 09/853,325 :
RCE FILED: JULY 19, 2005 : GROUP ART UNIT: 2141
FOR: MAIL-ARRIVAL NOTIFICATION :
SYSTEM, MAIL-ARRIVAL
MONITORING APPARATUS, MAIL
SERVER APPARATUS MOBILE
COMMUNICATION TERMINAL,
INFORMATION PROCESSING
APPARATUS, MAIL ACQUISITION
INSTRUCTING METHOD, MAIL
ACQUIRING METHOD, AND PROGRAM
STORING METHOD

REQUEST FOR WITHDRAWAL OF HOLDING OF ABANDONMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Notice of Abandonment, dated June 14, 2006, for failure to respond to the Office Action dated September 19, 2005. The applicant herewith requests withdrawal of said abandonment for the following reasons.

A Request for Continued Examination (RCE) was filed on July 19, 2005 by the Applicant's former representative. On September 8, 2005, Applicant filed a Power of Attorney (POA) changing to a new representative. The change was acknowledged by way of a Notice of Acceptance of Power of Attorney issued on September 21, 2005. Just prior to the POA being acknowledged, the examiner issued an Office Action mailed on September 19, 2005 to the Applicant's former representative. The Office Action was returned to the

Application No. 09/853,325

Reply to Notice of Abandonment dated June 14, 2006

U.S.P.T.O. without being delivered to the addressee (A copy of the returned envelope, obtained via the PAIR system, is attached). Since the Applicant was never made aware of the Office Action, failure to respond to the outstanding Office Action was not intentional.

Accordingly, it is requested the holding of abandonment be withdrawn and that prosecution be allowed to continue in the present application.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number

22850

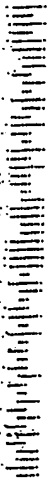
Tel: (703) 413-3000

Fax: (703) 413 -2220

(OSMMN 08/03)

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PHILIP



COMMISSIONER FOR PATENTS

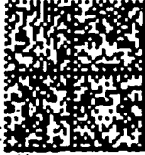
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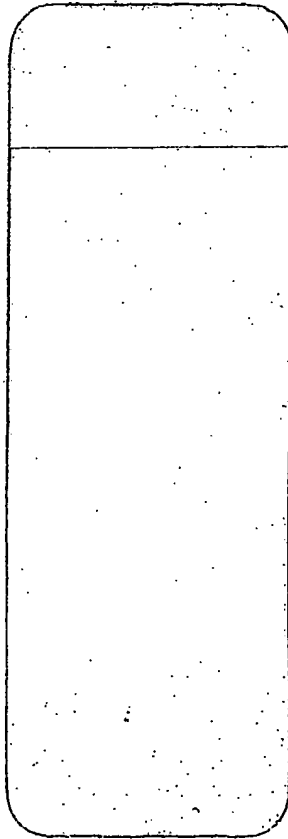
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,325	05/10/2001	Naoya Suzuki	450100-03214	5864
20999	7590	09/19/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			LUU, LE HIEN	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
OIPF/IAP
SEP 23 2005



Office Action Summary

Application No.

09/853,325

Applicant(s)

SUZUKI, NAOYA

Examiner

Le H. Luu

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/14/05 - 09/08/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

27

Art Unit: 2141

1. Claims 1-7, 9-12, 14-20 are presented for examination.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7, 9-12, 14-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims: "generating a summary of said urgent mail including information from said attached file". Examiner can not find this teaching anywhere in the specification.

4. Examiner will consider the limitation "generating a summary of said urgent mail including information from said attached file" when applicant points out where it can be found from applicant's original specification. For now, Examiner provides examination without considering the limitation as described below.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-7, 9-12, and 14-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by Cloutier et al. (Cloutier) patent no. 6,535,586.

7. As to claim 15, Cloutier teaches the invention as claimed, including a mobile communication terminal (col. 3 line 62 - col. 4 line 14; wireless communication device 170), comprising:

receiving means for receiving a mail-arrival notifying signal together with a summary of an electronic mail to make a notice that said electronic mail arriving at a

prescribed mail server is an urgent mail (col. 4 line 61 - col. 5 line 23; col. 5 lines 40-60); and
transmitting means for transmitting an acquisition instructing signal to instruct acquisition of said urgent mail, to a prescribed information processing apparatus by radio communications for short distance, based on said mail-arrival notifying signal (col. 6 line 36 - col. 7 line 52).

8. As to claims 16-17, Cloutier teaches said receiving means receives said mail-arrival notifying signal over a public radio circuit network, and said receiving means receives said mail-arrival notifying signal from a prescribed mail-arrival monitoring apparatus which judges an electronic mail arriving said mail server, by radio communications for short distance (col. 2 lines 30-49; col. 3 lines 11-19).

9. As to claim 18, Cloutier teaches notifying means for notifying a user of arrival of said urgent mail, in response to said mail-arrival notifying signal received (col. 3 line 62 - col. 4 line 14).

10. As to claim 19, Cloutier teaches said transmitting means transmits said acquisition instructing signal including a Message-ID of an electronic mail that is judged as an urgent mail, included in said mail-arrival notifying signal (Abstract).

11. As to claim 20, Cloutier teaches said transmitting means transmits said acquisition instructing signal to a prescribed information processing apparatus by radio

communications for short distance, in response to an operation button which is operated by a user to instruct transmission of said acquisition instructing signal (col. 2 lines 30-49; col. 6 line 36 - col. 7 line 25).

12. As to claims 1-7, 9-12, 14, and 21-24, limitations of claims 1-7, 9-12, 14, and 21-24 that are similar to limitations of claims 15-20 are being rejected under the same rationale. In additional, Cloutier teaches a mail server apparatus and mail arrival monitoring apparatus (col. 3 line 20 - col. 4 line 14). Moreover, Cloutier inherently teaches email's attachment or attached file.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu whose telephone number is 571-272-3884. The examiner can normally be reached on 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

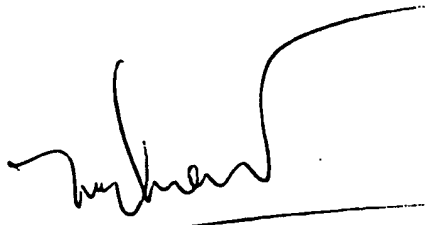
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 09/853,325

Page 6

Art Unit: 2141

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LE HIEN LUU
PRIMARY EXAMINER